

## REMARKS

The following remarks are submitted to address the above amendments and issues raised in the Official Action mailed April 7, 2006.

A Request for Extension of Time to extend the period for responding to this Office Action to August 7, 2006, is filed herewith.

Upon entry of the foregoing amendments, claims 1-23 are now pending in this application.

The Specification stands objected to because the Abstract of the Disclosure exceeds 150 words. Claims 1, 8, 13-14, 16, and 23 stand rejected under 35 USC § 103(a), as being unpatentable over Siems et al. (U.S. Patent No. 5,060,664) in view of Hall (U.S. Patent No. 4,174,720). Claims 9 and 11 stand rejected under 35 USC § 103(a), as being unpatentable over Siems et al. in view of Hall and in further view of Frank (U.S. Patent No. 4,291,713). Claims 10 and 12 stand rejected under 35 USC § 103(a), as being unpatentable over Siems et al. in view of Hall in view of Frank and in further view of Collins (U.S. Patent No. 5,200,020). Claims 2-7 and 17-22 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 15 stands allowed.

No new matter has been added. Support for requested amendments can be found in the original claims and throughout the present specification and drawings. Applicant respectfully requests consideration of the application in light of the above amendments and the following remarks.

### Specification

The objection to the Specification because the Abstract of the Disclosure exceeds 150 words is respectfully traversed.

The Official Action states that the Abstract of the Disclosure is objected to because it exceeds the 150 word limit, and that correction is required. (Official Action, p. 2.) Applicant has amended the Abstract of the Disclosure herein to have a length of less than 150 words.

For all of these reasons, the Office is respectfully requested to withdraw the objection to the Specification.

**Claims 13 and 14 – Substantial Duplicates**

The Official Action states that Applicant is advised that should claim 13 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof; and that, according to MPEP § 706.03(k), when two claims in an application are duplicates or else so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. (Official Action, p. 2.)

Applicant respectfully disagrees with the assertion that claim 14 is a substantial duplicate of claim 13. The inside surface and the outside surface of the paper wrapper are on opposite sides of the wrapper. While the wordings of claims 13 and 14 are similar, application of bands of adhesive to the *outside* surface of the paper wrapper, as in claim 14, requires a different arrangement of the adhesive applicator apparatus than for applying the bands of adhesive to the *inside* surface of the paper wrapper, as in claim 13. Therefore, claim 14 is not a substantial duplicate of claim 13.

**Claim 1, 8, 13-14, 16, and 23 — 35 USC § 103(a)**

The rejections of claim 1, 8, 13-14, 16, and 23 under 35 USC § 103(a), as being unpatentable over Siems et al. in view of Hall are respectfully traversed.

Claims 1 and 16 have been canceled herein. The Official Action states that claim 2 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Official Action, p. 5.) Claim 2 has been rewritten herein in

independent form including all of the limitations of the base claim and any intervening claims. Claims 8, 13, and 14 have been amended herein to depend from amended claim 2. Therefore, Applicant respectfully submits that claims 8, 13, and 14, as amended, are likewise allowable.

Claim 23 of the present invention, as amended, claims “[a]n apparatus for applying *bands* of an additive material to a strip of a paper wrapper within a *cigarette maker* having a garniture and a bobbin for paying out the strip of a paper wrapper to the garniture for wrapping about *smokable* material to form a cigarette rod, the apparatus comprising: a pair of counter-rotating rollers arranged between the bobbin and the garniture, one of the pair of rollers comprising a transfer roller having a peripheral surface and the other of the pair of rollers comprising an application roller having a peripheral surface; a means for supplying the additive material to a portion of the peripheral surface of the transfer roller *immediately upstream of a nip between the rollers . . .*” (Claim 23, emphasis added.)

The Official Action states that Siems et al. discloses an apparatus for making cigarette rods including a first and second component, comprising an adhesive applicator 19, deemed to be the claimed means for applying an additive material; a source of continuous paper web from paper reel 18; a wrapping mechanism deemed to be the claimed garniture for wrapping tobacco inside the continuous paper web. The Official Action states that Siems et al. does not disclose a pair of counter-rotating rollers, that Hall discloses an adhesive applicator having a first roller receiving adhesive from an adhesive reservoir and a second roller in contact with the first roller receiving adhesive from the first roller to transfer the adhesive to the paper web, and that at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have used Hall’s adhesive applicator with Siems et al. cigarette making apparatus in order to provide glue to the paper wrapping the tobacco filler. (Official Action, pp. 2-3.)

Siems et al. discloses a *filter rod* making machine including a first main section which includes means for forming a continuous composite unwrapped stream of *filter tow* and an atomized plasticizer, and a second main section which converts the stream into a continuous *filter rod* and subdivides the rod into *filter rod sections* of desired length. (Siems et al., col. 6, lines 34-47.) In the second main section, one side of a web 21 is coated with an adhesive from

paster 19, the *tow* is draped into the web 21 of wrapping material on a garniture conveyor belt 22, and the seam formed by the overlapping marginal portion of the draped web 21 is heated or cooled by a sealer 26. (Siems et al., col. 7, lines 34-50 (emphasis added).)

Nowhere does Siems et al. disclose an apparatus for applying *bands* of an additive material to a strip of a paper wrapper within a *cigarette maker* for wrapping about *smokable* material to form a cigarette rod, the apparatus comprising a pair of counter-rotating rollers arranged between the bobbin and the garniture, one of the pair of rollers comprising a transfer roller having a peripheral surface and the other of the pair of rollers comprising an application roller having a peripheral surface; and a means for supplying the additive material to a portion of the peripheral surface of the transfer roller *immediately upstream of a nip between the rollers*, as in claim 23 of the present application. In contrast, Siems et al. discloses coating one *side* of a web with an adhesive, and then draping the web about a *filter tow* on a garniture conveyor belt in order to make a *filter rod*, rather than applying *bands* of an additive material to a strip of a paper wrapper within a *cigarette maker* for wrapping about *smokable* material to form a *cigarette rod*. Therefore, Applicant respectfully submits that Siems et al. fails to disclose each and every element of the present invention. As such, Siems et al. is deficient as a reference with respect to claim 23.

Hall discloses a method and apparatus for forming a multi-sectional particulate-containing, cavity type cigarette *filter*. The apparatus includes a means for placing increments of a glue on *one side* of a stream of *plug wrap paper* at predetermined spacings from each other. A glue transfer apparatus having three vertically-aligned rollers can include a lowermost roller having a smooth surface or having a circumferential groove for picking up glue and transferring the glue to a second roller and then to a *plug wrap paper*. (Hall, col. 2, lines 27-29, 55-59; Fig. 2; col. 5, lines 43-64; col. 6, lines 21-26; Fig. 5; col. 6, lines 40-67.)

Hall also fails to disclose an apparatus for applying *bands* of an additive material to a strip of a paper wrapper within a *cigarette maker* having a garniture and a bobbin for paying out the strip of a paper wrapper to the garniture for wrapping about *smokable* material to form a *cigarette rod*, the apparatus comprising a pair of counter-rotating rollers arranged between the

bobbin and the garniture, one of the pair of rollers comprising a transfer roller having a peripheral surface and the other of the pair of rollers comprising an application roller having a peripheral surface; and a means for supplying the additive material to a portion of the peripheral surface of the transfer roller *immediately upstream of a nip between the rollers*, as in claim 23 of the present invention. In contrast, Hall discloses an apparatus for forming a cigarette *filter*. Accordingly, Hall fails to overcome the deficiency of Siems et al. as a reference with respect to claim 23.

Moreover, Applicant respectfully submits that neither Siems et al. nor Hall provide any suggestion or motivation to combine these two references. Neither reference teaches or suggests an apparatus for applying *bands* of an additive material to a strip of a paper wrapper within a *cigarette maker* for wrapping about *smokable* material to form a *cigarette rod*. Thus, combining these two references would provide no reasonable expectation of success for an apparatus for applying *bands* of an additive material to a strip of a paper wrapper within a *cigarette maker* for wrapping about *smokable* material to form a *cigarette rod*, as in claim 23 of the present invention. As a result, Applicant respectfully submits that claim 23 of the present invention is not obvious over Siems et al. in view of Hall.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 1, 8, 13-14, 16, and 23 under 35 USC § 103(a).

**Claims 9 and 11 — 35 USC § 103(a)**

The rejections of claims 9 and 11 under 35 USC § 103(a), as being unpatentable over Siems et al. in view of Hall and in further view of Frank are respectfully traversed.

The Official Action states that claim 2 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Official Action, p. 5.) Claim 2 has been rewritten herein in independent form including all of the limitations of the base claim and any intervening claims. Claims 9 and 11 have been amended herein to depend from amended claim 2. Therefore, Applicant respectfully submits that claims 9 and 11, as amended, are likewise allowable.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 9 and 11 under 35 USC § 103(a).

**Claims 10 and 12 — 35 USC § 103(a)**

The rejections of claims 10 and 12 under 35 USC § 103(a), as being unpatentable over Siems et al. in view of Hall in view of Frank and further in view of Collins et al. are respectfully traversed.

The Official Action states that claim 2 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Official Action, p. 5.) Claim 2 has been rewritten herein in independent form including all of the limitations of the base claim and any intervening claims. Claims 10 and 12 have been amended herein to depend from amended claim 2. Therefore, Applicant respectfully submits that claims 10 and 12, as amended, are likewise allowable.

For all of these reasons, the Office is respectfully requested to withdraw the rejections of claims 10 and 12 under 35 USC § 103(a).

**Claims 2-7, 15, and 17-22 – Allowable Subject Matter**

The objections to claims 2-7 and 17-22 as being dependent upon a rejected base claim are respectfully traversed.

The Official Action states that claims 2-7 and 17-22 are objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (Official Action, p. 5.) Claims 2-7 and 17-22 have been rewritten herein in independent form including all of the limitations of the base claim and any intervening claims. Therefore, Applicant respectfully submits that claims 2-7 and 17-22, as amended, should be allowed.

For all of these reasons, the Office is respectfully requested to withdraw the objections to claims 2-7 and 17-22.

Claim 15 stands allowed.

**CONCLUSION**

Applicant submits that a full and complete response has been made herein to the Official Action and, as such, all pending claims in this application are now in condition for allowance. Therefore, Applicant respectfully requests early consideration of the present application, entry of all amendments herein requested, withdrawal of all rejections and objections, and allowance of all pending claims.

The Office is respectfully invited to contact J. Michael Boggs at (336) 747-7536, to discuss any matter relating to this application.

Respectfully submitted,

8/1/06  
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Date

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